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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,548	03/01/2004	Robert A. Vito	IGC-PT001.4	9701
3624	7590	12/30/2005	EXAMINER	
VOLPE AND KOENIG, P.C. UNITED PLAZA, SUITE 1600 30 SOUTH 17TH STREET PHILADELPHIA, PA 19103			GOFMAN, ANNA	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 12/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/790,548	VITO ET AL.	
	Examiner	Art Unit	
	Anna Gofman	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>03/01/04;09/29/04</u> | 6) <input type="checkbox"/> Other: _____ |

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 03/01/04 has been considered by the examiner, however the following citations on page 6 are incomplete:
D379208, 0008053, 0055994

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites the limitation, "the athletic tape of claim 2, wherein the plurality of fibers are woven into a ribbon." It is unclear what Applicant implies by the fibers being "woven into a ribbon." Further, since the specification does not elaborate on this phrase, Examiner will interpret that said ribbon implies fibers woven into a narrow strip, tape or film.

Further, claim 24 recites the limitation, "the athletic tape of claim 12, wherein the support structure comprises a second elastomer having a plurality of particles therein." The spatial relation of said second elastomer is not specified and thus rejected.

4. Claim 25 provides for the use of "a material having a stretch axis and being adapted to regulate energy by distributing and partially dissipating energy exerted therefrom," but, since the claim does not set forth any steps involved in the

method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 25 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-53 are rejected under 35 U.S.C. 102(b) as being anticipated by Callinan et al. (US 6,030,655).

Callinan et al. teach an orthopedic support material, such as tapes, made of a substrate comprising a hardenable silicate-containing composition (pg.1 col.1 lines 5-7), capable of supporting a body part (pg.1 col.2 lines 24-25). This support material may be positioned on materials such as woven fabrics, containing a silicate composition (pg.2 col.3 lines 6-10), made of elastic yarns, which are heat shrinkable (pg.5 col.9 lines 35-39). Upon contact with water, the material undergoes little shrinkage (pg.3 col.5 lines 7-

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10), implying that the fabric is capable of water-shrinkage. The structure is made of elastic yarns, implying at least one elastic layer, thus meeting the limitation of claim 24. The stretchable substrate material comprises said support material, made of various fibers and particles (pg.5 col.9 lines 27-39). These fibers and particles include high modulus fibers such as fiberglass, ceramic fibers, metallic fibers, glass beads (pg.4 col.8 lines 23-27), sand (pg.3 col.5 line 38), and a filler, such as glass bubbles, which is a foam-like material (pg.8 col.15 line 26). The fabric comprises silicone, which is inherently a gel. Since the material is stretchable, it would inherently extend from a first position to a second position. In Example 7, Callinan et al. teach that this material (casting tape) was wound around a 5.08 cm diameter mandrel to make a 9-layer ring (pg.8 col.15 lines 4-7). Since these plurality of layers comprise the above mentioned fibers, the fibers are inherently stacked between four and sixteen times. This structure would inherently contain a woven ribbon, positioned in a wave-like form since ribbons are known in the art also as films, narrow strips, or tapes. Since the fibers are interwoven, the tape (or ribbon) would inherently be positioned in an at least partial non-linear, wave-like fashion. The structure results in a substantially waterproof cast (pg.3 col.5 lines 5-6). Thus, claims 1-53 are anticipated.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In addition to the references provided by Applicant, the follow documents are considered pertinent to Applicant's invention:

Sutton et al. (US 5,965,249) teach a composite elastic material but it is not woven.

Obeshaw (US 6,586,110) teaches a metal structure capable of stretching, but fail to disclose a heat-shrinkable material.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anna Gofman whose telephone number is (571) 272-7419. The examiner can normally be reached on Mon.-Fri. 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Anna Gofman
Examiner
Art Unit 1771

AG

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PRIMARY EXAMINER